

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Horst Dollinger, et al ) Art Unit: 1617  
Serial No.: 10/614,363 ) Examiner: S. Wang  
Conf. No.: 7879 )  
Filed: July 7, 2003  
For: 1-Phenyl-1, 2-Diaminoethane Derivatives as Modulators of the Chemokine  
Receptor Activity  
Docket No.: 01/1359

Box Amendment  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450  
November 20, 2006

**RESPONSE**

Sir:

This is in response to the Office Action dated September 22, 2006, setting forth a 1 month period for reply. Applicants are also filing herewith a Petition and fee for a one (1) month extension of time under 37 CFR 1.136(a), making this response due on or before November 22, 2006.

At page 2 of the office action, the Examiner sets forth a restriction requirement into 3 groups:

- I. Claims 1-2 and 11, drawn to a method of treating or preventing a disease wherein CCR3 receptor is involved, comprising administering a compound of Formula I or IA or IB<sup>1</sup>
- II. Claims 3-10 and 12, drawn to a compound of Formula IA or IB or a composition comprising the same<sup>2</sup>
- III. Claims 13 and 14, drawn to a process of preparing a compound of Formula IA or Formula IB<sup>3</sup>

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<sup>1</sup> The Examiner references only Formula I for Group I, but this Group also includes methods directed to Formulae IA and IB since Claim 11 covers this subject matter.

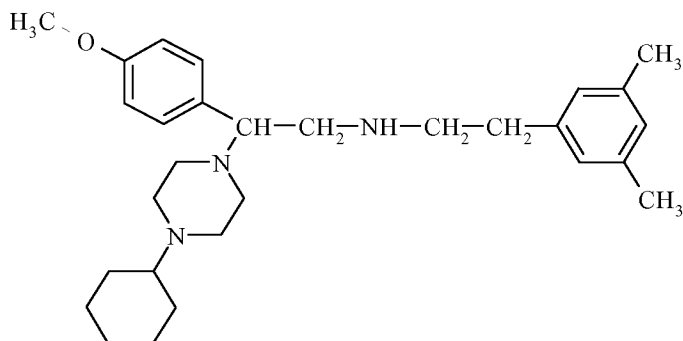
<sup>2</sup> The Examiner references only Formula IA for Group II, but this Group also includes Formula IB since Claims 7-10 and 12 cover this subject matter.

At page 3, the Examiner also requires an election of a single disclosed species for the compounds and diseases claimed.

In response, Applicants herein elect Group II, Claims 3-10 and 12. With respect to an election of species, Applicants herein elect the compound of Example 1D, the preparation of which is disclosed at page 34 of the specification. Claims 1-6 and 11-13 read upon this compound, its method of preparation or its method of use. This compound has the following chemical name and structure:

Example 1D

/2-(4-Cyclohexyl-piperazin-1-yl)-2-(4-methoxy-phenyl)-ethyl]-/2-(3,5-dimethyl-phenyl)-ethyl]-amin



Example 1D is a compound of formula IA, wherein:

R<sup>1</sup> and R<sup>2</sup> together with the interjacent nitrogen atom form a piperazine ring which is substituted in the 4-position by a cyclohexyl group,

R<sup>c</sup> is methoxy

R<sup>i</sup> and R<sup>g</sup> both are methyl,

and all other remaining R<sup>a</sup> through R<sup>j</sup> are hydrogen.

Applicants traverse the election of species requirement. Applicants submit that, at the very least, all the compounds of Formula IA as depicted in claims 3 to 6 constitute a proper Markush Group of compounds as they all share a common substantial structural core, as depicted by the

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<sup>3</sup> The Examiner references only Formula IA for Group III, but this Group also includes Formula IB since Claim 14 covers this subject matter.

structural formula shown in Claim 3, and all share a common utility as CCR-3 activity modulators having associated therapeutic utility. Accordingly, Applicants elect a single disclosed species herein on the understanding that this is done only to facilitate initial search and examination, but that this application will be generically examined in accordance with the USPTO's Markush Practice as outlined in MPEP § 803.02 in the event that the elected species is found to be patentable. That is, the search and examination would then be extended as necessary to determine the patentability of the compounds covered by the generic claims. In addition, Applicants submit that the compounds of Formula IB [Claims 7-10] are sufficiently structurally and functionally related to the compounds of Formula 1A [Claims 3-6] that they should be examined together in a single patent application and that this would not constitute an undue examination burden.

The Examiner is respectfully requested to identify, in the next communication in this application, the specific extent and scope of the examined subject matter.

Applicants appreciate the Examiner's acknowledgment (at pg. 5 of the Office Action) that the USPTO's Rejoinder Practice (MPEP § 821.04) is applicable to the present application. In the event that the product claims of Group II are found to be allowable, Applicants specifically request that the process (method) claims of Groups I and III be rejoined in the examination to the extent possible under the USPTO's Rejoinder Practice.

In view of the above remarks, Applicants respectfully submit that this application is now in condition for early examination. If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

/Philip I. Datlow/

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